REMARKS/ARGUMENTS

Claims 1 - 32 are currently pending. Claims 10 and 23 have been amended. Claim 30 - 32 have been added. No new matter has been added. Support for the amendments and added claims may be found at paragraph 19 and 20 and at FIGs. 1, 2, and 4 of the application as originally filed. Claim 1 - 6, 12 - 17, 20 - 21, and 27 - 29 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2, 4, 5, 9, and 10 of co-pending U.S. Patent Application No. 09/978,173 in view of Bohn (U.S. Patent Application No. 2003/0006956) and Chinen (U.S. Patent No. 6,099,929). A terminal disclaimer is submitted herewith to overcome the provisional obviousness-type double patenting rejection.

Claims 1 and 17 were rejected under 35 U.S.C. § 112, first paragraph, because the specification does not enable any person skilled in the art to which it pertains or with which it is most nearly connected, to make and use the invention commensurate with the scope of the claims.

Claims 10 and 23 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter with the applicant regards as the invention.

Claims 1 - 5, 7 - 8, 10 - 13, 17 - 21, and 23 - 26 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Bohn in view of Chinen.

Claims 6, 14 - 16, and 27 - 29 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Bohn and Chinen as applied to claim 1 or 12, and further in view of Culver (U.S. Patent No. 6,256,011).

Rejection Under 35 U.S.C. § 112, First Paragraph, Respectfully Traversed

Applicants respectfully traverse the Examiner's rejection that claim 1 is not enabled by the specification as originally filed. Applicants submit that one of skill in the art may make and use the input device as recited in claim 1 without undue experimentation. The Examiner asserts that description of a button that is cantilevered and sufficiently flexible to be

depressed fails to enable one to make and use a free extending button having a cantilever mounting such that the cantilever mounting provides "a spring force for the free extending button to return the free extending button to a neutral position subsequent to being pressed by a user," as recited in claim 1. The Examiner specifically asserts that description at page 1, paragraph 5 of the specification fails to enable the foregoing limitation of claim 1.

Applicants respectfully direct the Examiner to the enabling description for claim 1 at paragraph 20 and FIGs. 1, 2, and 4 of the application as originally filed. Applicant's counsel failed to direct the Examiner's attention to the enabling description in paragraph 20 for claim 1 in the Amendment of April 22, 2004. At paragraph 20, buttons 102 and 103 (see FIG. 1, 2, and 4), which are free extending and cantilever mounted to top housing 100, are described as having a flexion the biases buttons 102 and 103 up when the buttons are not depressed. One of skill in the art would readily be able to choose a material, without undue experimentation, that when cantilever mounted would provide an upward bias after being depression. For example, one top housing and button material described in the application as originally filed is metal, which may provide an upward bias after being depressed. Moreover, as described in paragraph 20, buttons 102 and 103 my be in a neutral position after being depressed as the buttons may or may not exert upward forces against the underside of the ledges 122 and 124 of island 120. That is, the forces on the button may be balanced (or neutral) after the button is depressed and biased upward. As one of skill in the art would readily be able to make and use the input device recited in claim 1 without undue experimentation, claim 1 is clearly enabled by the detailed description and figures as originally filed. Therefore, Applicants respectfully request the withdrawal of the 35 U.S.C. § 112, first paragraph, rejection of claim 1.

As claim 17 includes limitations similar to claim 1 discussed above, claim 17 is enabled for at least the same reasons as claim 1. Therefore, Applicants respectfully request the withdrawal of the 35 U.S.C. § 112, first paragraph, rejection of claim 17.

Rejection Under 35 U.S.C. § 112, Second Paragraph

Claims 10 and 23 have been amended to overcome the rejection over 35 U.S.C. § 112, second paragraph.

Bohn and Chinen Fail to Render Claims 1 and 11 Obvious

Applicants respectfully traverse the rejection of claim 1 as being obvious over Bohn in view of Chinen as Bohn and Chinen fail to show or suggest every limitation recited in claim 1. Specifically, Bohn and Chinen fail to show or suggest a free extending button having a "cantilever mounting providing a spring force for the free extending button to return the free extending button to a neutral position subsequent to being pressed by a user," as recited in claim 1.

Bohn, as understood, discusses a mouse having left and right buttons 14 and 16 configured to light LEDs 22 and/or 26 if either of the buttons is depressed. Applicants are in agreement with the Examiner that Bohn fails to teach or suggest a free extending button integrally formed with a top housing. As Bohn fails to teach or suggest the free extending button of claim 1, Bohn also fails to teach or suggest a free extending button that has a cantilever mounting that provides a spring force to return the free extending button to a neutral position subsequent to being pressed by a user.

Chinen fails to make up for the deficiencies of Bohn. Chinen discusses a flexible protective cover having an adhesive strip configured to attach to the cover of a control device. Chinen's protective cover includes one or two extending cover sections that are configured to cover the buttons of a control device. Nowhere does Chinen discuss that the protective cover is configured to provide a spring force to return the extending cover sections to a neutral position subsequent to being pressed by a user. Moreover, nowhere does Chinen or suggest the protective cover is configured to provide a spring force to return the extending cover sections to a neutral position subsequent to being pressed by a user. Specifically, the Chinen protective cover is configured to cover mouse buttons 1 and 2. It is well known to those of skill in the art that mouse buttons are coupled to springs means that are configured to provide return forces to the mouse buttons as the mouse buttons are depressed. As the Chinen protective cover is configured to overlie the mouse buttons, the return force of the mouse buttons supplies a return force to the extended cover sections to return the extended cover section to a neutral position. As the mouse buttons are configured to provide a return force to the protective cover, there is no suggestion

that the protective cover provides a return force to return the extended cover sections to a neutral position after being pressed. Therefore, Chinen fails to make up for the deficiencies of Bohn. Therefore, Bohn and Chinen fail to render claim 1 obvious.

The Examiner asserts that the protective cover of Chinen inherently would return to an original position after the extended cover sections are depressed. The Examiner has not indicated any language in Chinen that supports this assertion. Applicants note that merely because the Chinen plastic cover is flexible (see Chinen at Col. 2, line 50 among other places), this does not in any way imply that the protective cover provides a spring force to return the extended cover sections to a neutral position subsequent to being depressed. Flexibility merely implies the protective cover is capable of being bent or flexed and is pliable. Applicants respectfully request that the Examiner indicate the precise language of Chinen that shows or suggest that the Chinen protective cover is configured to provide a spring force to return the protective cover to a neutral position subsequent to being depressed.

Bohn and Chinen Fail to Render Claims 3, 12, and 17 Obvious

The rejection of claim 12 is traversed as Bohn and Chinen, either alone or in combination, fail to teach or suggest every limitation of claim 12. For example, Bohn and Chinen fail to teach or suggest "an island mounted on said body between said extending buttons, said island having lips extending over edges of said extending buttons so that a gap between said extending buttons and said island is not visible from above."

As an additional matter, neither Bohn nor Chinen teach or suggest an island having lips that extend over the edges of extending buttons. While Bohn shows a structure (un-numbered in Bohn's FIG. 1 and 6) partially surrounding a scroll wheel 18, the mechanical features of the structure are not described in Bohn, and certainly Bohn provides no description that the structure includes lips that cover edges of extending buttons. Chinen fails to make up for this deficiency of Bohn. Specifically, in Chinen's FIGs. 1 and 2, no island is shown disposed between buttons 2 and 3, and no island is described anywhere in Chinen that includes lips that extend over the edges of extending buttons. The only structure shown in Chinen's FIGs. 1 and 2 that is disposed between Chinen's buttons 2 and 3 is a scroll wheel 13. As Chinen's fails to even

mention an "island mounted on said body between said extending buttons," as recited in claim 12, Chinen certainly fails to show an island "having lips extending over edges of said extending buttons," also recited in claim 12. Because the lips of the island are not provided merely for comfort, and because Bohn and Chinen fail to teach, or even suggest, the foregoing described limitations of claim 12, Bohn and Chinen fail to render claim 12 obvious.

Bohn and Chinen Fail to Render Claim 7 Obvious

The Examiner asserts that extending the protective cover of Chinen to cover a back side of a mouse is obvious as this would provide protection for a back side of the mouse. Applicants respectfully disagree that extending the protective cover of Chinen is obvious as the Chinen cover is configured to prevent grease and dirt from entering the front buttons of a mouse. See Chinen at Col. 1, lines 37 - 41. As there are no buttons on the back side of the Bohn mouse or the Chinen mouse, prevention of dust entry and grease entry is not needed on the back side of the Bohn mouse or the Chinen mouse. The Examiner further asserts that extending the protective cover of Chinen provides more surface area for indicia, therefore it is obvious to extend the cover. Applicants respectfully disagree as indicia may be applied directly to the back side of the Chinen mouse without extending the protective cover to cover the back side. Extending the Chinen protective cover merely raises that cost of manufacturing the protective cover as more material would be used to fabricate and extended protective cover without any functional gain. Therefore, extending the Chinen cover to cover the back side of the Chinen mouse or the Bohn mouse is not obvious. Therefore, Bohn and Chinen fail to render claim 7 obvious.

Bohn, Chinen and Culver Fail to Render Claims 6, 14-16, and 27-29 Obvious

The rejection of claim 6 over Bohn, in view of Culver and Chinen is respectfully traversed as Bohn, Culver, and Chinen fail to show or suggest every limitation of claim 6. As an initial matter, Applicants are in agreement with the Examiner that Bohn fails to show or suggest "a cantilevered arm supporting the roller," as recited in claim 1. Applicants submit that Chinen

similarly does not show or suggest a cantilever arm configured to support a roller. Therefore, Bohn and Chinen in combination fail to render claim 6 obvious.

As an additional matter, Applicants respectfully submit that Culver is not art that may be combined with Bohn and Chinen, as the combination of the Culver device with the Bohn and Chinen devices would render the Culver device unsatisfactory for its intended purpose. MPEP § 2143.01 provides that if a proposed modification would render a prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. Specifically, Culver discusses an arm that is configured to rotate about an axis A, from a first side of the Culver device to a second side of the Culver device. See Culver FIG. 1 and col. 3, lines 45 - 65. The rotation motion of the Culver arm is configured to provide a first control signal to control movement of a graphical object along the x-axis of a display. See Culver at col. 5, lines 25 - 30. A roller mounted to the Culver arm is configured to provide a second control signal to control movement of the graphical object along the y-axis of the display. See Culver at col. 7, lines 9 - 15. If the Culver device were combined with the Bohn and Chinen devices, the rotation motion of the Culver arm would be eliminated as the buttons of the Bohn and Chinen devices would prevent the lateral rotation of the Chinen arm. Applicants respectfully submit, that if the lateral rotation motion of the Culver arm is eliminated by combining the Culver arm with the Bohn and Chinen devices, the Culver device would be rendered unsatisfactory for its intended purpose, namely the control of graphical objects along two axes. As the combination of the Culver, Bohn, and Chinen devices suggested by the Examiner would render the Culver device unsatisfactory for its intended purpose, there is no suggestion or motivation to combine Culver with Bohn and Chinen as proposed. Because there is no motivation to combine the Culver device with the Bohn and Chinen devices, and because Culver fails to show or suggest every limitation of claim 6, and because Bohn and Chinen fail to show or suggest every limitation of claim 6, claim 6 is not rendered obvious by Bohn, Culver and Chinen.

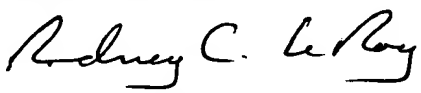
For at least the same reasons that Bohn, Culver and Chinen fail render claim 6 obvious, Bohn, Culver and Chinen fail to render claims 14 and 27 obvious.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 650-326-2400.

Respectfully submitted,



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